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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,473	10/08/2003	Missoum Moumene	DEP 5169	7470
27777	7590	05/19/2005	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			REIMERS, ANNETTE R	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/681,473	<b>Applicant(s)</b> MOUMENE ET AL.	
	<b>Examiner</b> Annette R. Reimers	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5-6, and 12-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bryan et al. (U.S. Patent Number 5,674,296).

Bryan et al. disclose a motion disc capable of maintaining intervertebral spacing and comprising a first and second prosthetic vertebral endplate, e.g. 42 and 44, respectively, of Figure 3, a first and second outer surface, e.g. 52 and 54, respectively, of Figure 3, adapted to mate with the first and second vertebral body, e.g. 112 and 114, respectively, of Figure 3, a first inner surface comprising a first peripheral surface (see peripheral surface between 22 and 62 of Figure 3), a second inner surface comprising a second peripheral surface (see peripheral surface between 22 and 64 of Figure 3), a first and second convex articulation surface, e.g. 62 and 64, respectively, of Figure 3, and a body portion connecting the first and second inner and outer surfaces, e.g. 42 and 44, respectively, of Figure 3. In addition, the body portion of each endplate comprises a posterior and an anterior portion where the anterior portion is equal in thickness to the posterior portion (see Figure 3 and Column 4 lines 12-13).

The motion disc also includes an articulating core member comprising a first articulation surface adapted for articulation with the first articulation of the first endplate (see Figure 3) and a second articulation surface adapted for articulation with the first articulation surface of the second endplate (see Figure 3).

Furthermore, the motion disc includes a peripheral elastomeric shock-absorbing component, e.g. 22 of Figures 3 and 4, comprising a first surface contacting and attached to the first peripheral surface of the first endplate (see the surface between 22 and 62 of Figure 3) and a second surface contacting and attached to the second peripheral surface of the second endplate (see the surface between 22 and 64 of Figure 3). Moreover, each peripheral surface of the shock-absorbing component is attached to the respective inner surface of each plate (see Figure 3).

The interior surface of each opposed endplate comprises a channel adapted to receive the peripheral shock absorber (see Figure 4). The motion disc comprises a sheath, e.g. 110 of Figure 3, adapted to enclose the articulation surfaces and a lubricant disposed on the first articulation surface (see Column 4 lines 31-49). Thus, the seal allows the disc area to remain permanently lubricated

The Bryan motion disc device also discloses a second articulating core member comprising a first articulation surface adapted for articulation with the first articulation of the first endplate (see Figure 6) and a second articulation surface adapted for articulation with the first articulation surface of the second endplate (see Figure 6) and a second peripheral shock-absorbing component comprising a first surface contacting the

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first peripheral surface of the first endplate and a second surface contacting the second peripheral surface of the second endplate (see Figure 6).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bryan et al. (U.S. Patent Number 5,674,296).

Bryan et al. disclose the claimed invention except for the core component consisting of polyethylene, PEEK, ceramic and metals. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Bryan with a core component consisting of polyethylene, PEEK, ceramic and metals, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bryan et al. (U.S. Patent Number 5,674,296). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Bryan with a first and second endplate comprising of a non-metallic material or a polymer composite material or a PEEK-carbon fiber composite material, since it has been held to be within the general skill of a worker in the art to select a known material

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on the basis of its suitability for the intended use as a matter of obvious design choice.

In re Leshin, 125 USPQ 416.

Claims 10,11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bryan et al. (U.S. Patent Number 5,674,296).

Bryan et al. disclose the claimed invention except for the anterior portion of each endplate being thicker than the posterior portion (claim 10), and the anterior portion of the peripheral shock absorber being thicker than the posterior portion (claim 16). It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the device of Bryan et al. where the anterior portion of each endplate and the peripheral shock absorber is thicker than the posterior portion, since it is just one of numerous shapes or configurations a person of ordinary skill in the art would find obvious for the purpose of making a device more beneficial for the user. In re Dailey and Eilers, 149 USPQ 47 (1966). With regard to claim 11, i.e. "wherein the lordosis produces an angle between 5 and 20 degrees," it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Bryan where the lordosis produces an angle between 5 and 20 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

***Response to Arguments***

Applicant's arguments filed on March 02, 2005 have been fully considered but they are not persuasive, because the motion disc of Bryan et al. is capable of maintaining intervertebral spacing (see Figures 1-3). Moreover, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR

*AK*

  
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